

Applicants: Meir Shinitzky et al.
Serial No.: 10/530,776
Filing Date: December 19, 2005
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REMARKS

Claims 49-72 and 135-212 are pending in the subject application. In a March 18, 2009 Office Action, the Examiner withdrew claims 49-72, 135-164, 169-180 and 186-212 as allegedly drawn to non-elected subject matter. Applicants have hereinabove amended claims 165 and 181. Claim 181 has been amended to correct a clerical error. Applicants maintain that no issue of new matter is raised by the amendment to claims 165 and 181. Accordingly, applicants request that the Examiner enter this Amendment. Upon entry of the Amendment, claims 165-168 and 181-185 insofar as they read on the elected species will be pending and under examination in the subject application.

Support for the amendments to claim 165 may be found, *inter alia*, on page 14, line 1, to page 16, line 3, of the specification as originally filed. Pursuant to MPEP 2173.05(i), "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ('[the] specification, having described the whole, necessarily described the part remaining.').".

Election/Restriction

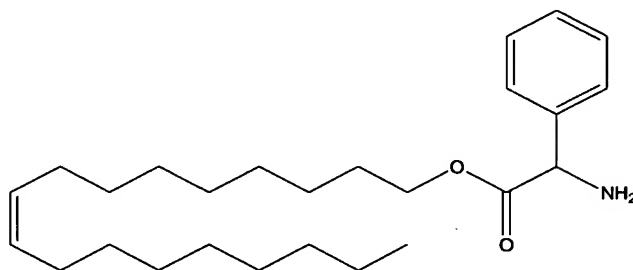
In the November 12, 2009 Office Action, the Examiner found the applicants' traversal of the September 22, 2008 Restriction Requirement unpersuasive and made the restriction requirement final.

As per MPEP 803.02, the Examiner will determine whether the entire scope of the claims is patentable.

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MPEP 803.02 provides that should the elected species appear allowable; the search of the Markush-type claim will be extended. If the search is extended and a non-elected species is not found allowable, the Markush-type claim shall be rejected and claims to the nonelected invention held withdrawn from further consideration.

The Examiner acknowledged that Applicants' elected species of the following compound:



makes a contribution over the prior art of record.

Therefore, the Examiner has extended the search of the Markush-type claim to include other species.

The Examiner then alleged that since a non-elected species has not been found allowable, the Markush-type claims have been rejected and the claims to the nonelected invention held withdrawn from further consideration.

Specifically, claims 165-168 and 181-185 have been examined to the extent to which they are readable on the elected embodiment and non-elected species. The Examiner alleges that since art was found on a nonelected species, subject matter not embraced by the elected embodiment or the above-identified nonelected species is therefore withdrawn from further consideration. The Examiner alleged that the entire scope

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claimed is not patentable.

Applicants' Reply

In response, Applicants have amended claim 165, and claims dependent thereon, to remove from its scope compounds in which R2 is not H or C₁-C₄ alkyl, when R3 is a pair of electrons, and R4 and R5 are each H.

Applicants submit that claim 165, and claims dependent thereon, are free of the prior art and respectfully request the Examiner to examine the full scope of the amended claims.

Rejections Under 35 U.S.C. §102(b)

The Examiner rejected claims 165-168 and 181-185 under 35 U.S.C. §102(b) as allegedly anticipated by Kida et al. [Kida T, Mizuno H, Takinami K, Matsunaka S (1977) Mechanism of Inhibitory Action of Lauryl_{DL} Valinate Hydro Chloride on Plant Growth. Agricultural and Biological 41, 931-8].

Specifically, the Examiner alleged that Kida et al. discloses the compound oleyl glycinate having the formula recited on page 6, paragraph 6, of the November 12, 2009 Office Action.

The Examiner further rejected claims 165-168 and 181-185 under 35 U.S.C. §102(b) as allegedly anticipated by Mori et al. [U.S. Patent No. 4,826,818].

Specifically, the Examiner alleged that Mori et al. teaches compounds of the formula R₁CH(NH)₂COOR₂ wherein R₁ is H, an alkyl, an ω-hydroxyalkyl, an aralkyl or an ω-hydroxyaralkyl group, and R₂ is a saturated or unsaturated hydrocarbyl having 2 to 22 carbon atoms.

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The specific compound which allegedly anticipates compounds of the present invention is of the formula recited on page 7, paragraph 7, of the November 12, 2009 Office Action.

Applicants' Reply

In response, without conceding the correctness of the Examiner's position and to merely expedite prosecution of the subject application, Applicants have amended claim 165 to exclude from its scope compounds in which R2 is not H or C₁-C₄ alkyl, when R3 is a pair of electrons, and R4 and R5 are each H.

Applicants submit that claim 165 and claims dependent thereon, as amended, are novel and allowable over the cited prior art.

In view of the preceding remarks, applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 165-168 and 181-185 under 35 U.S.C. §102(b).

Summary

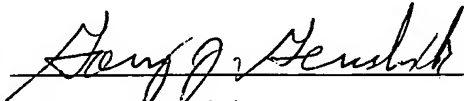
In view of the preceding remarks, applicants maintain that the pending claims are in condition for allowance, and respectfully request that the Examiner issue a notice of allowance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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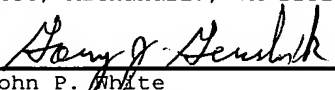
No fee is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

 2/12/10

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